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December 30, 2005  
Date of Signature

Re: Application of: Antonio Bogat  
Serial No.: 09/915,053  
Filed: July 25, 2001  
For: System and Method for Implementing Financial  
Transactions using Cellular Telephone Data  
Group Art Unit: 2643  
Confirmation No. 6099  
Examiner: Rexford N. Barnie  
MMB Docket No.: 1001-0727  
NCR Docket No. 9422

TRANSMITTAL OF APPEAL BRIEF

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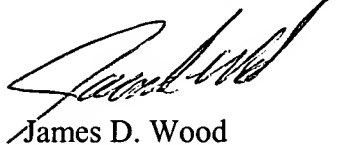
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Page 2

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Respectfully Submitted,

MAGINOT, MOORE & BECK



December 30, 2005

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Enclosures



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

NCR Docket No. **9422**

MMB Docket No. **1001-0727**

Confirmation No. **6099**

Application of: **Antonio Bogat**

Group Art Unit: **2643**

Serial No. **09/915,053**

Examiner: **Rexford N. Barnie**

Filed: **July 25, 2001**

For: **SYSTEM AND METHOD FOR IMPLEMENTING FINANCIAL  
TRANSACTIONS USING CELLULAR TELEPHONE DATA**

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**APPEAL BRIEF**

Sir:

This is an appeal under 37 CFR § 1.191 to the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office from the final rejection of the claims 1-25 of the above-identified patent application. These claims were indicated as finally rejected in a final Office Action dated August 4, 2005. The \$500.00 fee required under 37 CFR § 41.20(b)(2) is filed herewith. Also, please provide any

extensions of time that may be necessary and charge any fees that may be due to Account No. 13-0014, but not to include any payment of issue fees.

**(1) REAL PARTY IN INTEREST**

NCR Corporation of Dayton, Ohio is the assignee of this patent application, and the real party in interest.

**(2) RELATED APPEALS AND INTERFERENCES**

There are no appeals or interferences related to this patent application (serial no. 09/915,053).

**(3) STATUS OF CLAIMS**

Claims 1-25 are pending in the application.

Claims 1-25 are finally rejected.

Claims 1-25 are being appealed, and are shown in the Appendix attached to this Appeal Brief.

**(4) STATUS OF AMENDMENTS**

Appellant has filed no amendments after receipt of the August 4, 2005, Final Office Action (the "Office Action").

**(5) SUMMARY OF CLAIMED SUBJECT MATTER**

The present invention relates to a system for supporting transactions without the need for transaction tokens such as physical credit cards. (Appellant's specification at page 1, lines 4-6). In one embodiment, a consumer selects products and presents them at a merchant's terminal, such as a cashier's terminal, where the products are identified to the terminal in the normal manner. (Appellant's specification at page 9, line 19 through page 10 line 1, page 15, lines 9-13 and FIG. 4). The total amount of the transaction, a transaction code, and a payment processing center telephone number are then presented to the consumer. (Appellant's specification at page 10, lines 2-8). The consumer then places a call to the payment processing center and enters the transaction code. (Appellant's specification at page 15, lines 18-21 and FIG. 4). At or about the same time, the merchant terminal sends merchant transaction data to the payment processing center. (Appellant's specification at page 15, lines 18-21 and FIG. 4).

A transaction record generator at the payment processing center receives consumer transaction data and merchant transaction data and correlates the two. (Appellant's specification at page 16, lines 2-4 and FIG. 4). The consumer transaction data may include, in addition to the transaction number, cellular phone identification such as the cellular phone number, an electronic serial number, a merchant identifier, and/or the transaction amount. (Appellant's specification at page 12, lines 4-12). The merchant transaction data includes the total amount of the transaction, and may further include a merchant identification code, and or a transaction identification code. (Appellant's specification at page 10, lines 15-17). The merchant identification code may identify the retailer, the particular store, a city and state, and/or terminal identification. (Appellant's

specification at page 10, lines 17-20). Once the merchant transaction data and the consumer transaction data are correlated, a transaction record is generated that includes at least some of the merchant transaction data as well as at least some of the consumer transaction data. (Appellant's specification at page 13, line 4 through page 14, line 7, page 16 lines 2-4 and FIG. 4).

The transaction record generator may then query a billing platform associated with the cellular phone to obtain approval for payment of the transaction. (Appellant's specification at page 16, lines 5-6 and FIG. 4). If approved, an approval code is generated and transmitted to either the cellular phone and/or the merchant's terminal. (Appellant's specification at page 16, lines 10-12 and FIG. 4). The goods are then released to the consumer.

Accordingly, the present invention eliminates the need for a customer to carry a number of different credit cards into a retail establishment while still providing secure access to financial accounts so that the customer may make purchases.

#### **(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1-3, 8-10, 15-17 and 21-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,088,683 to Jalili (hereinafter "Jalili") in view of U.S. Patent Application Publication No. US 2002/0147658 A1 of Kwan (hereinafter "Kwan");

Claims 4, 5 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kwan in view of U.S. Patent No. 5,778,173 of Apte (hereinafter "Apte");

Claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kwan in view of Apte in further view of U.S. Patent No. 6,473,739 B1 of Showghi et al. (hereinafter “Showghi”) or U.S. Patent Application Publication No. 2002/0010678 A1 of Utsunomiya (hereinafter “Utsunomiya”);

Claims 11, 12 and 18-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jalili in view of Kwan in further view of Apte;

Claims 13 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jalili in view of Kwan in further view of Apte and in further view of Showghi or Utsunomiya;

Claims 21-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kwan in view of Jalili; and

Claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kwan in view of Jalili in further view of Apte.

## **(7) ARGUMENT**

### **Claims 1-3 and 8-10 Are Not Obvious**

Claims 1-3 and 8-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jalili in view of Kwan. The invention of claims 1-3 and 8-10 is not obvious when the invention is considered as a whole.

#### *Discussion Regarding Claim 1*

##### **1. Claim 1**

Claim 1 states:

A system for supporting consumer transactions billed to an account through a cellular telephone comprising:  
 a merchant data receiver for receiving merchant transaction data from a merchant terminal at a transaction site;  
 a consumer data receiver for receiving consumer transaction data from a cellular telephone at the transaction site; and  
 a transaction processor for processing the merchant transaction data and the consumer transaction data to access a financial account so that approval for a transaction at the transaction site may be obtained.

Claim 1 thus recites a system for receiving data related to a single transaction through two different communication links which both originate at the same location. Accordingly, claim 1 recites a merchant terminal that is at the same location as a cellular telephone, and that is used to transmit merchant transaction data to a merchant data receiver.

## 2. There is No Motivation for the Proposed Modification

The Examiner appears to admit that neither Jalili nor Kwan anticipate the invention of claim 1 but alleges that together, the prior art discloses all of the limitations of claim 1. (Office Action at page 2). The Examiner has proposed that the motivation for the combination of the prior art may be found on either of two bases. Neither of the proposed motivations is sufficient.

### a. Mobility is Unrelated to the Required Modification

The Examiner relied primarily upon Jalili in rejecting claim 1 with reference to Kwan for teaching the use of a cellular telephone. (Office Action at page 2). The motivation that the Examiner proposed for this modification is “to make it possible to use any communication device” in the system of Jalili so that the system of Jalili could be



used over a wide geographical area. (Office Action at page 3). Motivation for incorporation of a cellular telephone is not germane to the element missing in Jalili.

Jalili fails to disclose a merchant terminal that is at the same location as a cellular telephone, and that is used to transmit merchant transaction data to a merchant data receiver. As discussed more fully below, Jalili does not disclose, teach or suggest that the user of the Jalili system is collocated with the merchant terminal. Thus, merely providing a cellular telephone does not arrive at the invention of claim 1 since the merchant terminal must be collocated with the cellular telephone that is used to transmit consumer transaction data.

As the Federal Circuit has stated, “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *In re Werner Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2D 1313, 1317 (Fed. Cir. 2000). Accordingly, the motivation to combine the references *in the manner proposed* must explain why one of skill in the art would modify the system of Jalili to incorporate a cellular telephone so that the system could be used at the location where the merchant terminal is located.

The proposed motivation of mobility/freedom of use fails to provide any such motivation. Rather, it would appear that to the extent freedom of use is desired, the motivation for adding a cellular telephone would be to allow a user to access the internet outside of the confines of the home. Thus, in the same manner that the internet obviates the need to be physically at the merchant’s place of business, the cellular telephone obviates the need for the customer to be at home. The Examiner has failed to identify any motivation for incorporating a cellular telephone into the system of Jalili so that a

customer can access a merchant's web-site while the customer is physically located at the merchant's web-site.

Therefore, because the rejection of claim 1 requires more than merely a cellular telephone to be incorporated into the system of Jalili, the motivation of increasing the geographical area of use is not sufficient motivation to combine the prior art in the manner proposed.

b. There is No Additional Benefit Achieved

The Examiner further opined that a motivation for combining Jalili and Kwan was to reduce "fraudulent charging of one's account by checking and collaborating ANI information." (Office Action at page 3). There is no benefit from the proposed combination.

While neither Jalili nor Kwan use the acronym "ANI" and the Examiner did not explain what the acronym meant, the Appellant notes that "ANI" is frequently used as an acronym for "automatic number identification." In this context, ANI is defined as "[a] service that tells the recipient of a telephone call the telephone number of the person making the call. This number can be passed to computer equipment to automatically retrieve associated information about the caller, i.e. account status, billing records, etc." *The Free On-line Dictionary of Computing*, <http://www.foldoc.org/>, Editor Denis Howe. Jalili fully discloses the use of the telephone number of the telephone used to make a call at column 2, lines 40-48. In fact, Jalili notes that in addition to using the telephone number, a personal identification number (PIN) is used. (Jalili at column 2, lines 40-48).

Therefore, while motivation to combine references may be found in an advantage arising from the combination (see MPEP 2144), there can be no advantage from the proposed combination when the alleged advantage is *already present* in the system which the Examiner proposes to modify. Accordingly, the Examiner has failed to identify a legally cognizable motivation for the combination of Jalili and Kwan.

c. Conclusion

Therefore, the Examiner has failed to identify any motivation for making the proposed modifications. Accordingly, a *prima facie* case of obviousness under MPEP 2142 has not been established and the Board of Appeals is respectfully requested to reverse this rejection of claim 1.

3. Jalili has been Mischaracterized

Even if the cited art is combined in the manner proposed by the Examiner, the combination fails to arrive at the invention of claim 1. The Examiner has alleged that Jalili discloses all of the elements of claim 1 with the exception of a cellular telephone. Jalili does not, however, disclose a merchant terminal that is used at the same location as a cellular telephone, and that transmits merchant transaction data.

The Examiner contends that Jalili discloses this element at column 2, lines 28-39 and column 2, lines 40-65. (Office Action at page 9). At column 2, lines 28-39, Jalili discloses a merchant sending information to a processing center. Although no specific location of the merchant is identified, it is reasonable to assume that the information is sent *from the merchant's location* which in Jalili is a web-site. Thus, Jalili discloses

transmission of merchant data over a first communications link from the web-site of the merchant.

At column 2, lines 40-65, Jalili discloses that the customer accesses the processing center. Assuming, *arguendo* that the information transmitted is “customer transaction data,” as recited by the claim, the communication must still originate at the same location as the link used in transmitting the merchant data. Jalili, however, is silent as to where the customer is when the call to the processing center is made. Of course, since Jalili is directed to a system for making purchases over the internet, the location of the customer at the time of purchase is not geographically linked to the location of the merchant’s web-site.

Jalili does disclose that in response to a call from the customer to the processing center, “the processing center lists all outstanding invoices and gives the customer the opportunity to make a selection and thereby express intent to complete the sale.” (Jalili at column 2, lines 49-53). Therefore, Jalili clearly indicates that the call need not be made at or near the time that the merchant data is transmitted to the processing center. Thus, the system of Jalili is simply a virtual shopping cart which is filled and at some later time, a purchase may be made. There is, however, no temporal linkage between the transmission of merchant transaction data and the transmission of customer transaction data in the system of Jalili.

Therefore, there is no nexus, either geographical or temporal, between the transmission of merchant data and the telephone call in the system of Jalili. Accordingly, even if the system of Jalili is modified to incorporate a cellular telephone, as proposed by the Examiner, the resulting system does not teach or disclose a merchant terminal that is

at the same location as a cellular telephone, and that is used to transmit merchant transaction data to a merchant data receiver. Rather, the user of the system of Jalili may browse the internet and select products for future purchase without geographical constraint.

Therefore, because the modification of Jalili proposed by the Examiner does not teach, disclose or suggest a merchant terminal that is at the same location as a cellular telephone, and that is used to transmit merchant transaction data to a merchant data receiver as recited in claim 1, the proposed modification does not arrive at the invention of claim 1.

#### 4. Jalili's Merchant Data is Not Processed to Access Financial Account

Moreover, claim 1 recites that both the merchant data and the customer data, both of which are sent from the transaction site, are used to access a financial account. Jalili does not disclose merchant data i) received from the transaction site that is ii) used to access a financial account as claimed.

Specifically, Jalili discloses that some data is sent from the "merchant" to the processing center. (See e.g. Jalili at column 2, lines 28-31). However, the data from the "merchant" of Jalili is not used to access a financial account. Rather, access to a financial account appears to be based upon the entry of the proper personal identification number (PIN) by a user and subsequent approval of the sale by the user. (Jalili at column 2, lines 40-44 and 49-53). The approval of a particular invoice is indicated either verbally or by pressing the number on a telephone corresponding to the listed order of the approved invoice. (Id. at column 2, lines 57-64) However, both the PIN and the number

on the telephone entered by the user in response to a list generated by the processing center come from the user's telephone or computer.

Therefore, even assuming *arguendo* that the PIN or approval code of Jalili could be interpreted as being "merchant data", neither of them is sent from a merchant terminal. Thus, Jalili does not disclose the use of merchant data received from a merchant terminal at the transaction site to access a financial account as recited in claim 1. Accordingly, even accepting the proposed combination so as to include a cellular phone at some point in the system of Jalili, the proposed combination does not arrive at the invention recited in claim 1 and under MPEP § 2143.03, claim 1 is patentable over the prior art.

## 5. Conclusion

For any or all of the reasons set forth above, a *prima facie* case of obviousness has not been established with respect to claim 1 and the Board of Appeals is respectfully requested to reverse the rejection of claim 1.

### *Discussion Regarding Claims 2-3 and 8-10*

The Examiner rejected claims 2-3 and 8-10 on the same grounds as claim 1. (Office Action at page 2). Claims 2 and 3 depend from claim 1 and include all of the limitations of claim 1. Therefore, for any of the reasons set forth above with respect to claim 1, the Board of Appeals is respectfully requested to reverse the rejection of claims 2 and 3.

Claim 8 is an independent claim that has been rejected on the same combination discussed above with respect to claim 1. (Office Action at page 2). Claim 8 includes,

for purposes of this appeal, the same limitations discussed above with respect to claim 1.

Claims 9 and 10 depend from claim 8 and include all of the limitations of claim 8.

Therefore, for any of the reasons set forth above with respect to claim 1, the Board of Appeals is respectfully requested to reverse the rejection of claims 8-10.

### **Claims 4, 5 and 7 Are Not Obvious**

Claims 4, 5 and 7 stand rejected under 35 U.S.C. §103(a) as being obvious over Kwan in view of Apte. (Office Action at page 3). These claims are allowable for at least the reasons set forth below.

#### *Discussion Regarding Claim 4*

1. Claim 4

Claim 4 states:

A terminal for supporting consumer transactions billed through an account through a cellular telephone comprising:  
a transaction data generator for generating transaction data; and  
a transaction data display for displaying the generated transaction data with a telephone number so that a consumer may call the telephone number to bill a transaction corresponding to the generated transaction data to an account associated with a cellular telephone number.

Claim 4 thus recites a terminal with a display that allows a user to view a telephone number to call in order to pay for a product using an account associated with a cellular telephone number.

2. There is No Motivation for the Proposed Modification

The Examiner admitted that Kwan fails to disclose each element of claim 4 but alleged that the missing element could be found in Apte. (Office Action at page 4).

Because there is no motivation for the proposed combination, the rejection should be reversed.

Specifically, the Examiner has alleged that the motivation to combine the teachings of Kwan with the teaching of Apte is “to complete a purchase and confirming (sic) a transaction for security/billing reasons.” (Office Action at page 4). The system of Kwan as disclosed, however, already provides for both completing a purchase and confirming a transaction for security/billing reasons. At paragraph 26, the user confirms the purchase of an item by providing a random number associated with the transaction. After this, payment is authenticated (Kwan at paragraph 27) and the merchant is paid (Kwan at paragraph 29).

Therefore, while motivation to combine references may be found in an advantage arising from the combination, there can be no advantage from the proposed combination when the alleged advantage is *already present* in the system which the Examiner proposes to modify. Accordingly, the Examiner has failed to identify a legally cognizable motivation for the combination of Kwan and Apte.

### 3. The Cited Art Does Not Disclose a Terminal As Claimed.

The Examiner rejected claim 4 based primarily upon Kwan, relying upon Apte only for teaching the display of a telephone number to a user. (Office Action at pages 3-4). Neither Kwan nor Apte disclose a terminal with a transaction data generator and a display.

Specifically, the Examiner identified the system disclosed in paragraphs 25-32 of Kwan as including the limitations recited in claim 4 of a terminal with both a transaction



data generator and a display. In paragraph 25, however, the disclosed terminal is the *customer's* terminal which is being used to browse the Internet. (Kwan at paragraph 25). Thus, while the terminal relied upon by the Examiner may inherently include a display, there is no teaching in Kwan that the customer terminal includes a *transaction generator*. Rather, to the extent there is a transaction generator in Kwan, such a transaction generator would be located either at the merchant's server or at the payment processor 40 since information related to the transaction is transmitted from the merchant's server to the payment processor 40 through connection 51 and a random number is transmitted from the payment processor 40 to the merchant's server through connection 58. (Kwan at paragraph 25 and FIG. 2).

Moreover, Apte merely discloses the display of a telephone number on the *user's* computer, not at a merchant's terminal. (Apte at column 3, lines 39-50).

Therefore, neither Kwan nor Apte teaches, discloses or suggests a Merchant's terminal that includes both a transaction generator and a display for displaying a telephone number to a customer. Thus, even modifying the system of Kwan with the teaching of Apte as proposed does not arrive at the invention recited in claim 4.

Accordingly, under MPEP § 2143.03, claim 4 is patentable over the prior art and the Board of Appeals is respectfully requested to reverse the rejection of claim 4.

#### 4. Conclusion

Therefore, for any or all of the above reasons, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claim 4. Accordingly, the Board of Appeals is respectfully requested to reverse this rejection of claim 4.

*Discussion Regarding Claims 5 and 7*

Claims 5 and 7 depend, either directly or by way of an intermediate claim, from claim 4 and include the limitation discussed above with respect to claim 4 and additional limitations. Accordingly, for at least the same reasons set forth above with respect to claim 4, claims 5 and 7 are patentable over the prior art and the Board of Appeals is respectfully requested to reverse the rejection of claims 5 and 7.

**Claim 6 is Not Obvious**

Claim 6 stands rejected under 35 U.S.C. §103(a) as being obvious over Kwan in view of Apte in further view of Showghi or Utsunomiya. (Office Action at page 4). Claim 6 depends from claim 4 and includes additional limitations. The Examiner has relied upon Showghi or Utsunomiya for disclosing only those limitations added by claim 6. Thus, neither Showghi nor Utsunomiya correct the deficiencies identified in the prior art with respect to claim 4. Therefore, even if Showghi or Utsunomiya is combined with Kwan and Apte, the combination fails to arrive at the invention of claim 6. Accordingly, the Board of Appeals is respectfully requested to reverse the rejection of claim 6.

**Claims 11-12 are Not Obvious***Discussion Regarding Claim 11*

1. Claim 11

Claim 11 recites:

The system of claim 8, the merchant terminal further comprising:  
a transaction data generator for generating transaction data; and

a transaction data display for displaying the generated transaction data with a telephone number so that a consumer may call the telephone number to bill a transaction corresponding to the generated transaction data to an account associated with a cellular telephone number.

Claim 11 thus recites a merchant terminal that includes a transaction data generator and a transaction data display.

## 2. The Discussion of Claim 1 Applies

As an initial matter, Claim 11 depends from claim 8 and includes all of the limitations of claim 8. The Examiner has rejected claim 11 based primarily upon Jalili and Kwan with reliance on Apte for teaching the display of a telephone number. (Office Action at page 5). Accordingly, Apte fails to correct the deficiencies discussed above with the combination of Jalili and Kwan regarding the elements of claim 8. Therefore, a *prima facie* case of obviousness has not been presented with respect to claim 11. Accordingly, the Board of Appeals is respectfully requested to reverse the rejection of claim 11.

## 2. The Proposed Combination Does Not Disclose the Claimed Merchant Terminal

Moreover, claim 11 recites a *merchant terminal* with a “display for displaying the generated transaction data” along with a telephone number for the consumer to use in completing the transaction. Even assuming *arguendo* that the merchant servers of Jalili or Kwan are merchant terminals, the proposed modification of Jalili and Kwan with the teaching of Apte does not arrive at the invention recited in claim 11.

Specifically, both Jalili and Kwan disclose systems wherein information displayed to the customer is displayed *on the customer's terminal*. (See, e.g., Jalili at column 2, lines 15-22 and Kwan at paragraph 26). Additionally, the Examiner has cited to Apte at column 3, lines 39-59 for enabling a secure electronic transaction. (Office Action at page 5). Within the cited passage, Apte discloses a typical internet connection wherein a customer uses a computer to connect to the internet “in a conventional manner.” (Apte at column 3, lines 39-41). Thereafter, information from the vendor is transmitted to the *customer's computer*. (Id. at column 3, lines 43-47). Thus, it is the *customer's computer* at which data (including any telephone number) is displayed to the customer. The *customer's computer* is not a *merchant terminal*.

In response to the above argument, the Examiner stated that Jalili discloses an apparatus for sending an email which could “arguably” be a computer terminal. (Office Action at page 9). According to this argument, the information may in fact be displayed at the merchant's terminal. Jalili specifically states, however, that any such email or invoice is used to deliver the information *to the processing center*. The claim, however, recites that the data is for use *by the customer*. A *processing center* is not a *customer* as those terms are used in any of the references or in the specification. Therefore, even if there is a display at the merchant's web-site, the information is not used by the customer. Thus, the Examiner has failed to provide support for his position.

Therefore, even if the *customer terminals* of Jalili and Kwan are modified to display a telephone number to the *customer* as proposed by the Examiner, such modification cannot fairly be said to teach or suggest a *merchant terminal* with a display for displaying a telephone number for the consumer to use. Thus, the proposed

modification does not arrive at the invention recited in claim 11 and under MPEP § 2143.03, claim 11 is patentable over the prior art.

### 3. Conclusion

For any or all of the foregoing reasons, it is respectfully submitted that the modification of Jalili in view of Kwan in further view of Apte fails to arrive at the invention of claim 11. Accordingly, the Board of Appeals is respectfully requested to reverse the rejection of claim 11.

#### *Discussion Regarding Claim 12*

Claim 12 depends from claim 11 and includes the limitations discussed above with respect to claim 11 and additional limitations. Accordingly, for at least the same reasons set forth above with respect to claim 11, claim 12 is patentable over the prior art.

#### **Claims 13-14 are Not Obvious**

Claims 13 and 14 stand rejected under 35 U.S.C. §103(a) as being obvious over Jalili, Kwan and Apte in further view of Showghi or Utsunomiya. (Office Action at page 6). Claims 13 and 14 depend, by way of one or more intermediate claims, from claim 11 and include additional limitations. The Examiner has relied upon Showghi or Utsunomiya for disclosing only those limitations added by claims 13 and 14. Thus, neither Showghi nor Utsunomiya correct the deficiencies identified in the prior art with respect to claim 11. Therefore, even if Showghi or Utsunomiya is combined with Jalili, Kwan and Apte, the combination fails to arrive at the invention of claims 13 and 14.

Accordingly, the Board of Appeals is respectfully requested to reverse the rejection of claims 13 and 14.

### **Claims 15-17 are Not Obvious**

#### *Discussion Regarding Claim 15*

1. Claim 15 recites:

A method for supporting payment of a consumer transaction through an account associated with a cellular telephone comprising:  
generating a transaction record from merchant transaction data and consumer cellular telephone data;  
querying for payment through an account associated with the cellular telephone data; and  
generating an approval code in correspondence with a response to the query for payment through the account associated with the cellular telephone data.

Claim 15 thus recites generating a transaction record from cellular phone data.

2. Jalili Has Been Mischaracterized

The Examiner has alleged that Jalili uses customer data received through the cellular telephone to generate a transaction record. (Office Action at page 2).

Jalili does disclose using a telephone system's CallerID function to identify the particular user calling the processing center. (Jalili at column 2, lines 41-44). However, Jalili does not disclose any further use of that information. Therefore, Jalili does not disclose generating a transaction record *from* cellular phone data as recited in the claim.

Thus, even accepting *arguendo* the proposed combination so as to include a cellular phone at some point in the system of Jalili, the proposed combination does not arrive at the invention recited in claim 15. Accordingly, under MPEP § 2143.03, claim 15 is patentable over the prior art.

*Discussion Regarding Claims 16-17*

Claims 16-17 depend from claim 15 and include the limitations discussed above with respect to claim 15 and additional limitations. Accordingly, for at least the same reasons set forth above with respect to claim 15, claims 16-17 are patentable over the prior art.

**Claims 18-20 are Not Obvious**

Claims 18-20 have been rejected based upon the same arguments and prior art discussed above with respect to claim 11. (Office Action at page 5). Claim 18 depends from claim 15 by way of claim 16. Therefore, for the same reason set forth above with respect to claim 15, claim 18 is patentable over the prior art.

Claim 18 further includes a step directed to the display of a telephone number at the transaction site for the customer's use. Since the steps of claim 18 require generation of merchant transaction data at the transaction site (see claim 16), and because claim 18 recites that the display is also at the transaction site, then for purposes of this appeal, the step added by claim 18 is the same limitation as the display at the merchant's terminal discussed above with respect to claim 11. Therefore, for at least the same reasons set forth above with respect to the merchant terminal display of claim 11, claim 18 is patentable over the prior art.

Claims 19-20 depend from claim 18 and include the limitations discussed above with respect to claim 18 and additional limitations. Accordingly, for at least the same

reasons set forth above with respect to claim 18, claims 19-20 are patentable over the prior art.

### **Claims 21-24 are Not Obvious**

The Examiner has admitted that all of the elements of claims 21-24 are not taught, disclosed or suggested by Kwan. (Office Action at pages 6-7). The Examiner opines that the missing elements are disclosed in Jalili. (Office Action at pages 6-7). Because there is no motivation for the proposed combination, a *prima facie* case of obviousness has not been established.

Specifically, the Examiner alleges that the motivation to combine the references is to “[make] it possible to deter fraud and make sure that a customer is indeed being billed for a desired or selected service.” (Office Action at page 7). These benefits, however, are already provided by the system disclosed by Kwan. For example, in accordance with Kwan, upon receiving merchant data regarding a potential purchase, the system calls the telephone number provided by the customer when first registering for use of the system. (Kwan at paragraph 26). Subsequently, the actual user of the telephone is authenticated by requiring the customer to provide a password or by authenticating the user’s voice pattern. (Kwan at paragraph 27).

Therefore, while motivation to combine references may be found in an advantage arising from the combination, there can be no advantage from the proposed combination when the alleged advantage is *already present* in the system which the Examiner proposes to modify. Accordingly, the Examiner has failed to identify a legally cognizable motivation for the modification of Kwan with Jalili. Because there is no



motivation for the proposed combination, the Examiner has failed to present a *prima facie* case of obviousness and the Board of Appeals is respectfully requested to reverse the rejection of claim 21-24.

### **Claim 25 is Not Obvious**

#### *Discussion Regarding Claim 25*

1. Claim 25

Claim 25 states:

The system of claim 24, further comprising:  
a display for displaying a telephone number so that a consumer may call the telephone number to bill the transaction to an account associated with a telephone number associated with the cellular telephone.

Claim 25 thus recites a system with a display that allows a user to view a telephone number to call in order to pay for a product using an account associated with a cellular telephone number.

2. The Discussion of Claim 24 Applies

As an initial matter, Claim 25 depends from claim 24 and includes all of the limitations of claim 24. The Examiner has rejected claim 25 based upon the same prior art discussed above with respect to claim 24 with further reference to Apte for the limitations added by claim 25. (Office Action at page 8). Therefore, for the same reasons set forth above with respect to claim 24, a *prima facie* case of obviousness has not been presented with respect to claim 25. Accordingly, the Board of Appeals is respectfully requested to reverse the rejection of claim 24.

### 3. There is No Motivation for the Proposed Additional Modification

The Examiner states that the motivation to modify Kwan with Apte with respect to claim 25 is the same motivation for the same combination discussed above with respect to claim 4. (Office Action at page 8). Therefore, for the same reasons set forth with respect to claim 4, there is no motivation for the proposed modification of Kwan with Apte with respect to claim 25. Thus, it is respectfully submitted that a *prima facie* case of obviousness has not been presented and the Board of Appeals is respectfully requested to reverse the rejection of claim 25.

### 4. Conclusion

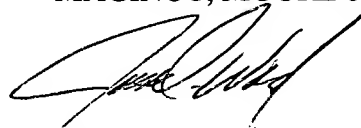
Therefore, for the reasons set forth above claim 25 is patentable over the prior art and the Board of Appeals is respectfully requested to reverse this rejection of claim 25.

**(8) CONCLUSION**

Claims 1-3, 8-10, 15-17 and 21-23 are not obvious over Jalili in view of Kwan and claims 4, 5 and 7 are not obvious over Kwan in view of Apte. Claim 6 is not obvious over Kwan in view of Apte in further view of Showghi or Utsunomiya. Moreover, claims 11, 12 and 18-20 are not obvious over Jalili in view of Kwan in further view of Apte and claims 13 and 14 are not obvious over Jalili in view of Kwan in further view of Apte in further view of Showghi or Utsunomiya. Additionally, claims 21-24 are not obvious over Kwan in view of Jalili and claim 25 is not obvious over Kwan in view of Jalili in further view of Apte. Accordingly, the Board of Appeals is respectfully requested to reverse the rejections of claims 1-25.

Respectfully submitted,

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December 30, 2005

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**(9) CLAIMS APPENDIX**

Claim 1. A system for supporting consumer transactions billed to an account through a cellular telephone comprising:

a merchant data receiver for receiving merchant transaction data from a merchant terminal at a transaction site;

a consumer data receiver for receiving consumer transaction data from a cellular telephone at the transaction site; and

a transaction processor for processing the merchant transaction data and the consumer transaction data to access a financial account so that approval for a transaction at the transaction site may be obtained.

Claim 2. The system of claim 1, the transaction processor further comprising:

a transaction record generator for generating a transaction record corresponding to the merchant transaction data and the consumer transaction data; and

an approval query generator that queries for approval of the transaction at the transaction site using the generated transaction record.

Claim 3. The system of claim 2 further comprising:

an approval transmitter for transmitting an approval code to one of the cellular telephone and the merchant terminal at the transaction site in response to a response to the query from the approval query generator.

Claim 4. A terminal for supporting consumer transactions billed through an account through a cellular telephone comprising:

a transaction data generator for generating transaction data; and

a transaction data display for displaying the generated transaction data with a telephone number so that a consumer may call the telephone number to bill a transaction corresponding to the generated transaction data to an account associated with a cellular telephone number.

Claim 5. The terminal of claim 4 further comprising:

a transaction data transmitter for transmitting the generated transaction data with merchant data to a payment processing site for approval of the transaction.

Claim 6. The terminal of claim 4 further comprising:

an option payment generator for generating a menu of payment options for the transaction data display to display, the generated menu including an option to pay for a transaction corresponding to the generated transaction data by means of an account associated with a cellular telephone.

Claim 7. The terminal of claim 5 further comprising:

an approval receiver for receiving an approval code for a transaction corresponding to the transaction data transmitted by the transaction data generator so that the transaction corresponding to the transaction data is funded by an account associated with a cellular telephone number.

Claim 8. A system for supporting transactions billed to an account associated with a cellular telephone comprising:

- a merchant terminal for generating and sending merchant transaction data;

- a consumer data receiver for receiving consumer transaction data from a cellular telephone at the transaction site; and

- a transaction processor for processing the merchant transaction data and the consumer transaction data to access a financial account so that approval for a transaction at the transaction site may be obtained.

Claim 9. The system of claim 8, the transaction processor further comprising:

- a transaction record generator for generating a transaction record corresponding to the merchant transaction data and the consumer transaction data; and

- an approval query generator that queries for approval of the transaction at the transaction site using the generated transaction record.

Claim 10. The system of claim 9 further comprising:

- an approval transmitter for transmitting an approval code to one of the cellular telephone and the merchant terminal at the transaction site in response to a response to the query from the approval query generator.

Claim 11. The system of claim 8, the merchant terminal further comprising:  
a transaction data generator for generating transaction data; and  
a transaction data display for displaying the generated transaction data with a telephone number so that a consumer may call the telephone number to bill a transaction corresponding to the generated transaction data to an account associated with a cellular telephone number.

Claim 12. The system of claim 11, the merchant terminal further comprising:  
a transaction data transmitter for transmitting the generated transaction data with merchant data to a payment processing site for approval of the transaction.

Claim 13. The system of claim 12, the terminal further comprising:  
an option payment generator for generating a menu of payment options for the transaction data display to display, the generated menu including an option to pay for a transaction corresponding to the generated transaction data by means of an account associated with a cellular telephone.

Claim 14. The system of claim 13, the terminal further comprising:  
an approval receiver for receiving an approval code for a transaction corresponding to the transaction data transmitted by the transaction data generator so that the transaction corresponding to the transaction data is funded by an account associated with a cellular telephone number.

Claim 15. A method for supporting payment of a consumer transaction through an account associated with a cellular telephone comprising:

generating a transaction record from merchant transaction data and consumer cellular telephone data;

querying for payment through an account associated with the cellular telephone data; and

generating an approval code in correspondence with a response to the query for payment through the account associated with the cellular telephone data.

Claim 16. The method of claim 15 further comprising:

generating merchant transaction data to identify a merchant and a consumer transaction at a transaction site; and

receiving consumer cellular telephone data from a cellular phone network.

Claim 17. The method of claim 16 further comprising:

sending the generated approval code to one of a cellular phone and a merchant terminal located at the transaction site.

Claim 18. The method of claim 16 further comprising:

displaying a telephone number for payment processing at the transaction site so a consumer may call the telephone number with a cellular phone to pay for the consumer transaction through an account associated with the cellular phone.



Claim 19. The method of claim 18 wherein the telephone number is displayed in response to an option to pay for the consumer transaction through an account associated with the cellular telephone being selected.

Claim 20. The method of claim 19 wherein the merchant transaction data generation includes identifying a merchant account so that funds may be transferred from the account associated with the cellular telephone number to the merchant account.

Claim 21. A method of processing data used to obtain approval for a payment associated with a transaction comprising:

- receiving from a transaction site a merchant transaction specific merchant data;
- receiving from a cellular telephone at the transaction site transaction specific consumer transaction data;
- correlating the received transaction specific merchant data and transaction specific consumer transaction data ; and
- using the correlated data to obtain approval to charge a payment associated with the transaction to an account associated with the cellular telephone.

Claim 22. The method of claim 21, further comprising:

- generating at least some of the transaction specific merchant data using a cost of a product selected by the consumer.

Claim 23. The method of claim 22, further comprising:

generating at least some of the transaction specific consumer transaction data using a merchant terminal; and  
displaying the at least some of the transaction specific consumer transaction data.

Claim 24. A system for supporting consumer transactions billed to an account through a cellular telephone comprising:

a merchant data receiver for receiving merchant transaction data from a merchant terminal at a transaction site over a first communications link;

a consumer data receiver for receiving data from a consumer cellular telephone at the transaction site over a second communications link; and

a transaction processor for processing the merchant transaction data and the consumer transaction data to access a financial account so that approval for a transaction at the transaction site may be obtained.

Claim 25. The system of claim 24, further comprising:

a display for displaying a telephone number so that a consumer may call the telephone number to bill the transaction to an account associated with a telephone number associated with the cellular telephone.

**(10) EVIDENCE APPENDIX**

None

**(11) RELATED PROCEEDINGS APPENDIX**

None.